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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79164940
Applicant	ICON S.R.L.
Applied for Mark	INSIGHT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant: ICON S.R.L.

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Ser. No.: 79/164,940

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I. INTRODUCTION

Applicant, ICON S.R.L. (“Applicant”), through its undersigned counsel, hereby files its brief in support of its appeal of the Final Office Action of the Examiner herein (the “Office Action”), making final the refusal to register Applicant’s Mark INSIGHT for certain services in Class 35 on the ground of confusing similarity with the registered marks INSIGHT. For the reasons set forth herein, and in all of Applicant’s prior responses to the Examiner which are incorporated herein by reference, Applicant respectfully submits that the Examiner’s refusal should be reversed and that Applicant’s Mark should be registered.

II. BACKGROUND

In the initial May 29, 2015 office action following the filing of the application to register Applicant’s Mark, the Examiner refused to register Applicant’s Mark in Class 35 on the ground of confusing similarity with the following two marks under Section 2(d) of the Trademark Act:

Trademark:	INSIGHT
Reg. No.:	808,682
Reg. Date:	May 17, 1966
Goods/Svs.:	Advertisement research service for industrial and commercial organizations

Class: 35
Owner: Robert A. Owens

Trademark: INSIGHT
Reg. No.: 3,893,996
Reg. Date: December 21, 2010
Goods/Svs.: Business research services in the retail eyewear and eyecare industries, namely, conducting business and market research surveys, preparing periodical reports based on the results of such surveys

Class: 35
Owner: Jobson Medical Information LLC

On November 28, 2015, Applicant filed a response to the first office action, in which it rebutted the Examiner's arguments and submitted additional evidence and arguments. The Examiner issued a second office action on December 20, 2015, in which she responded to Applicant's rebuttals, to which the Applicant responded by filing a Petition to Divide and a Notice of Appeal. The application was divided on July 11, 2016. The application that is the subject of this appeal now covers only Class 35.

III. ARGUMENT

Under the Trademark Act, a refusal to register grounded in a likelihood of confusion requires that such confusion be not merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson Inc.*, 222 U.S.P.Q. 367, 368 (T.T.A.B. 1983) (*quoting Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969) (“We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which trademark law deals.”)). The factors that are examined to evaluate confusing similarity are set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The factors most relevant here are (1) the dissimilarity of the marks in question, (2) the dissimilarity of the services, and (3) the co-existence of similar marks.

A. The Dissimilarity of the Marks in Question

It is well settled that marks must be compared in their entireties, including all disclaimed matter; and they should not be dissected so as to compare only the shared components thereof. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687 (Fed. Cir. 1993); *In re MCI Communications Corp.*, 21 U.S.P.Q.2d 1534 (Comm'r Pat. 1991); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). That is because in adjudging the similarity of the marks, the relevant standard is the “total effect” of the mark, considering sight, sound, and meaning. *See Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 8115, 2 U.S.P.Q.2d 1264 (1st Cir. 1987). “Similarity of the marks must be considered in light of what occurs in the marketplace, taking into account the ‘circumstances surrounding the purchase of the goods’ or services.” *Calamari Fisheries, Inc. v. The Village Catch, Inc.*, 698 F. Supp. 994, 1009, 8 U.S.P.Q.2d 1953 (D. Mass 1988).

Elements that distinguish marks in appearance, sound and meaning must be considered in the likelihood of confusion analysis. For example, in *In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), the court considered whether there was a likelihood of confusion between VARGA GIRL and VARGAS both for calendars with pictures by the artist Alberto Vargas. In finding no confusion, the court stated: “Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.... When GIRL is given fair weight, along with VARGA, confusion with VARGA becomes less likely.” *Id.* *See also, Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 U.S.P.Q. 272, 273-274 (C.C.P.A. 1974) (“That marks must be considered in their entireties in determining whether there is likelihood of confusion or mistake is a basic rule in comparison of marks. Here the board . . . sought to establish an exception to the rule, namely: if the most prominent feature of a mark

creates a commercial impression separate and apart from the remaining features of the mark, any confusing similarity with respect to it is determinative with respect to the mark in its entirety. We know of no authority which supports such an exception and hold that the board erred on this point.”).

“Similarity of the marks must be considered in light of what occurs in the marketplace, taking into account the ‘circumstances surrounding the purchase of the goods’ or services.” *Calamari Fisheries, Inc. v. The Village Catch, Inc.*, 698 F. Supp. 994, 1009, 8 U.S.P.Q.2d 1953 (D. Mass 1988). The ordinary consumer normally will perceive a mark as a whole and will not analyze its details. The visual, sound and connotation aspects in the parties’ marks must be assessed by referring to the overall impressions created by the marks. The mere fact that two marks contain the same or similar components is not dispositive. As Applicant has argued, when Applicant’s mark and the cited marks are so compared, the dissimilarities outweigh any similarities.

The stylization of Applicant’s mark is significant and distinguishing. (As discussed below, “in sight” and “insight” have entirely different meanings.) The bold typeface of IN in Applicant’s mark is a dominant focus point in Applicant’s mark. It highlights the letters IN and drives the potential customer to see these letters as a separate word and concept.

The Examiner has based her continued refusal to register on the assertion that the marks are identical and phonetic equivalents. This disregards the fact that the bold letters IN are dominant. The Examiner further ignores that such stylization does create a separation of the letters IN and SIGHT in the mind of one encountering the mark. Despite this, the Examiner continues to argue that Applicant’s mark and the cited marks are phonetic equivalents with the same plain meaning and connotation.

The mere fact that the marks share elements, even dominant elements, does not compel a finding of likelihood of confusion. As discussed above, in *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992), the Federal Circuit held that the Board had erred in focusing primarily on the common elements of the marks VARGA GIRL and VARGAS, while not affording the differentiating and descriptive term GIRL substantial weight. *Id.* at 494. The Federal Circuit held that the addition of the term GIRL created a different sound, appearance and commercial impression to negate a likelihood of confusion, notwithstanding the fact that the term VARGA was considered “dominant.” *Id. Accord, General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622,627 (8th Cir. 1987) (“The use of identical, even dominant words in common does not automatically mean that two marks are similar”) (citation omitted).

The similarity of the marks, standing alone, is not enough to justify a finding of likelihood of confusion, and the courts, the CCPA and TTAB have regularly held marks to not be confusingly similar even though one mark incorporated a portion, or the entirety, of another mark, and where both marks were used in connection with related products or services. *See, e.g., Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1109 (C.C.P.A. 1972) (applicant’s ALL CLEAR used in connection with household cleaner held not confusingly similar to registrant’s ALL used with household cleaning products even though the two marks shared the common term ALL and were used on virtually identical products); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884 (Fed. Cir. 1986) (ROMAN and ROMANBURGER for food products found not confusingly similar); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364, 366 (T.T.A.B. 1974) (applicant’s MMI MENSWEAR used with men’s clothing held not confusingly similar to registrant’s MEN’S WEAR used in connection with the same); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975) (applicant’s COUNTRY

VOGUES used in connection with women's dresses held not confusingly similar to VOGUE used in connection with a women's fashion magazine); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970) (PEAK and PEAK PERIOD for dentifrice and deodorant, respectively, found not confusingly similar).

The focus should be on the obvious differences in the marks, namely, the bold IN in Applicant's mark, which is more than sufficiently dissimilar from the cited marks. The Examiner has not offered any expert, survey, consumer, or other evidence to support any argument that the bold IN is not the dominant part of Applicant's mark.

The bolding of the initial letters "IN" in Applicant's mark forces an emphasis on these letters, separating them from "SIGHT" and bringing an entirely new sound, which is unlike the sound of either of the cited marks. The bold "IN" is a distinct auditory marker. This cannot be ignored when comparing the overall sounds of the marks at issue. *See, e.g., J. Wiss & Sons, Co. v. Gee Whiz Tool Corp.*, 364 F.2d 910 (6th Cir. 1966) (WIZZ and GEE WHIZ not similar); *Plough, Inc. v. Kreis Labs.*, 314 F.2d 635 (9th Cir. 1963) (COPPERTAN and COPA not similar to COCA TAN); *Coca Cola, Co. v. Essential Prods., Co.*, 421 F.2d 1374 (C.C.P.A. 1970) (COCO LOCO and COCA COLA not similar); and *Standard Brands, Inc. v. Eastern Shore Canning Co.*, 172 F.2d 144 (4th Cir. 1949) (V-8 for vegetable juice and VA for tomato juice not similar).

The Applicant's mark and the cited marks are further distinguishable in meaning and commercial impression. Applicant's mark consists of two components, the bolded letters IN and the word SIGHT. The bolding of IN drives the viewer to see the mark as two words. The connotation and commercial impression thus become the words "in sight." Applicant's mark thus conveys an impression of something that is within the sight of the viewer or consumer. This

idiom can mean:

1. within the range of vision; visible. The goal is in sight. The end of the road is in sight.
2. known; expected. The end of the project is finally in sight.
3. before one's eyes; also, within one's awareness.

See definitions from TheFreeDictionary.com submitted concurrently with Applicant's response to the initial office action and incorporated therein by reference.

When these meanings are placed in the context of Applicant's goods and services, namely, hair care preparations and services related thereto, the connotation and commercial impression become even stronger. The consumer thinks of someone's hair and/or the effects of Applicant's products and services as being close at hand and within the consumer's grasp. That is, the consumer herself is indeed immanently capable of obtaining the intended or promoted results of the Applicant's goods and services. Applicant's mark thus makes a unique commercial impression and conveys a specific and readily understandable connotation. The Examiner has presented no evidence to show that this is not the case. There is also no evidence that consumers of Applicant's goods or services will ask for them by the one-word term "insight" rather than the two-word term "in sight." The very nature of Applicant's goods and services will reinforce the two-word nature of Applicant's mark and its meaning in consumers' minds.

On the other hand, neither of the cited marks has any stylization. These marks thus can only be seen as one-word marks. The single word "insight" has several different well-known meanings and connotations:

1. an instance of apprehending the true nature of a thing, especially through intuitive understanding.

2. penetrating mental vision or discernment; faculty of seeing into inner character or underlying truth.
3. in Psychology:
 - a. an understanding of relationships that sheds light on or helps solve a problem.
 - b. (in psychotherapy) the recognition of sources of emotional difficulty.
 - c. an understanding of the motivational forces behind one's actions, thoughts, or behavior; self-knowledge.

See definitions from Dictionary.com being submitted concurrently with Applicant's response to the initial office action and incorporated therein by reference. These meanings all relate to the specific services covered by the cited marks.

Where marks have different connotations when used with their respective goods or services, or where marks are highly suggestive as applied to their respective goods, there is no likelihood of confusion. Here, the commercial impressions and connotations of Applicant's mark and the cited marks are therefore distinctly different. Thus there can be no likelihood of confusion.

As demonstrated by the co-existing marks discussed below, the specific services in connection with which the mark is used serve to distinguish marks containing other identical or similar components. This is evidenced by the co-existence of the cited marks with the marks registered in Class 35 discussed below. This co-existence proves that there is no likelihood of confusion between INSIGHT marks merely due to the commonality of general terms in their identifications of services.

Applicant's mark suggests a very clear conceptual and distinct meaning when applied to its hair care products and related Class 35 services that is foreign to those of the cited marks. This is a significantly different meaning and commercial connotation from any meaning or commercial impression that either cited mark might convey. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998) (CRISTAL for champagne and CRYSTAL CREEK for wine not confusingly similar because each evoked very different images in the minds of relevant consumers: while the former suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter suggested a very clear (and hence probably remote from civilization) creek or stream); *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987) (finding no confusion likely between CROSS-OVER for brassieres and CROSSOVER for ladies' sportswear due to the different meanings of the marks when applied to the goods); *In re British Bulldog, Ltd.* 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984) (finding no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for men's shoes because the term "has somewhat different connotations when applied to these different goods").

Even identical marks (which here the parties' marks are not) are not confusingly similar if they have different meanings. A determination of a mark's meaning must be made in relation to the goods or services it covers, and trade dress such as the ads, catalogs, look books, runway backgrounds, labels and hang tags may enlighten whether a mark projects a confusingly similar or different meaning or impression. *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.* 223 U.S.P.Q. 1281 (Fed. Cir. 1984) (applicant's argument that its SPICE VALLEY Mark was not similar to the exotic, distant lands image evoked by opposer's SPICE ISLANDS mark was

held rebutted by evidence of applicant's trade dress labels featuring a square rigged sailing ship).

If VARGAS and VARGAS GIRL, ROMAN and ROMANBURGER, ALL and ALL CLEAR, and PEAK and PEAK PERIOD are not confusingly similar, then PLISSÉ and EPLISSÉ plainly are not. Applicant's Mark and the cited marks must be compared in detail. When that comparison is made, there is no question that Applicant's mark imparts a distinct appearance, sound, meaning and commercial impression. As such, consumers are not likely to be confused into believing that Applicant's services emanate from or are otherwise associated with the owners of the cited marks. Nor are they likely to believe that the services of the cited marks are in any way connected with Applicant's services. Accordingly, there can be no likelihood of confusion between the marks.

In light of the foregoing factors, Applicant respectfully submits that its mark is readily distinguishable from the cited marks in overall sight, sound and meaning. And, for these reasons, it is respectfully requested that the Examiner's refusal based upon the cited registrations be reversed.

B. The Dissimilarity of the Services

The different services covered by the cited marks and Applicant's mark distinguish their respective marks. As the amended identification of the Class 35 services demonstrates, all of Applicant's Class 35 services relate to hair care and hair care products and services. The services covered by Reg. No. 808,682 all relate to advertisement research. This is supported by the last specimen filed in support of this registration, a copy of which was attached to Applicant's last office action response and incorporated therein by reference. These services are different from providing actual advertising services. The services covered by Reg. No. 3,893,996 (as they have been narrowed since first being cited against Applicant's mark) are even

more distinct. They all relate only to the retail eyewear and eye care industries. These industries are completely unrelated to the hair care industries.

Indeed, for the reasons set forth above, the cited marks have been allowed to co-exist with one another. There is no reason why Applicant's mark should not be allowed to co-exist with them. As further discussed below, other registered marks for INSIGHT and INSIGHTS, with and without design elements or stylization, are distinguishable by virtue of the different services. This, despite the fact that some of their services may, as asserted by the Examiner with respect to the marks at issue herein, arguably overlap with or encompass one another. Yet, they have also been allowed to co-exist with each other and the cited marks.

C. The Co-Existence of Similar Marks

A review of currently registered and allowed marks, and those previously registered at the time the cited marks were registered, reveals that the Trademark Office has allowed several marks to co-exist with both the cited marks and other similar marks in Class 35. The cited marks are not the only one-word INSIGHT or INSIGHTS marks. The following current or former U.S. trademark registrations for INSIGHT and INSIGHTS in Class 35 demonstrate that the specific services and areas thereof serve to distinguish the marks (copies of the TESS printouts of which were attached to Applicant's response to the first office action and incorporated therein by reference):

- U.S. Registration No. 4,238,541 for INSIGHT for "Data processing services; Preparing custom business reports;"

- U.S. Registration No. 3,272,431 for INSIGHT for "Bringing together, for the benefit of others, of travel guides in the form of printed matter, travel brochures, travel directories, travel catalogues, guide maps, road maps, passport folders, and all other printed travel publications and

travel stationery goods, excluding the transport thereof, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of travel guides in the form of printed matter, travel brochures, travel directories, travel catalogues, guide maps, road maps, passport folders, and all other printed travel publications and travel stationery goods, excluding the transport thereof, enabling customers to conveniently view and purchase those goods from a general merchandise web site in the global communications network;”

- U.S. Registration No. 3,363,375 for inSight for “human resources services, namely, providing information and data relating to human resources to employers, employees and retirees;”

- U.S. Registration No. 3,323,800 for INSIGHT (Stylized) for “News clipping services from broadcast, print and Internet media for the purposes of reporting news and advertising which matches a client's profile of interest;”

- U.S. Registration No. 2,985,394 for INSIGHT and Design for “tracking sales of products off shelves and, based on the data so collected, providing reports and advice on improving sales, planograms and financial programs;”

- U.S. Registration No. 4,362,678 for INSIGHT for, among other things, “Providing an on-line computer database featuring trade information in the field of travel and hospitality;”

- U.S. Registration No. 3,690,982 for INSIGHT for, among other things, “Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; asset disposal services, namely, assisting in the disposal of computer hardware, software, servers, networks, and workstations; labeling, tagging, and tracking services, namely, monitoring and tracking of

computer hardware, software, servers, networks, and workstations; domestic and international pricing services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others;”

- U.S. Registration No. 3,060,668 for INSIGHT for “relocation services for the healthcare industry;”

- U.S. Registration No. 2,155,264 for INSIGHT for “providing information relating to import and export information, history and regulations by means of a computer accessible data base;”

- U.S. Registration No. 2,067,844 for INSIGHT for “information services, namely providing information to employers about potential employees;”

- U.S. Registration No. 1,760,202 for INSIGHT and Design for “marketing and promotional services for frequency-based marketing system; namely, providing database support services; tracking and analyzing performance levels and issuing interim reports thereon; issuing identification cards for program members; and conducting direct mail campaigns;”

- U.S. Registration No. 1,758,699 for INSIGHT for “marketing and promotional services for frequency-based marketing system; namely, providing database support services; tracking and analyzing performance levels and issuing interim reports thereon; issuing identification cards for program members; and conducting direct mail campaigns;”

- U.S. Registration No. 1,888,789 for INSIGHT for “business management consulting services, excluding marketing research services;”

- U.S. Registration No. 1,855,338 for INSIGHT for “efficiency consulting services in the field of retail store displays; analyzing the profit for a specific time period for a group of products in a given sale space volume, and recommending a change in product mix and sale space volume to maximize profits for the specific time period;”

- U.S. Registration No. 1,472,593 for INSIGHT for “information storage and retrieval services in the field of customer shipment data;”

- U.S. Registration No. 1,473,453 for INSIGHT for “information storage and retrieval services in the field of customer shipment data;”

- U.S. Registration No. 4,792,675 for INSIGHTS for “Arranging and conducting business conferences in the field of human resources;”

- U.S. Registration No. 3,530,584 for INSIGHTS for “Conducting trade shows and business conferences in the field of property restoration;”

- U.S. Registration No. 1,109,635 for INSIGHTS and Design for “computerized market research services;” and

- U.S. Registration No. 1,160,258 for INSIGHTS for “Computerized Market Research Services.”

All of these marks were allowed registration in Class 35 despite the marks being identical or highly similar. The only reason therefor is that the services are distinguishable. So too are Applicant’s Class 35 services distinguishable from those of these registrations. Moreover, as discussed above, Applicant’s mark is equally distinguishable in overall sight, sound and meaning.

In view of the foregoing, the terms INSIGHT and INSIGHTS have become diluted in Class 35. The mere existence of the terms in service marks is therefore, in and of itself, not a

basis to find a likelihood of confusion. The co-existence of the two cited marks with each other, as well as with the above-discussed marks, demonstrates that purchasers of Class 35 services can distinguish between all of these marks. Purchasers of Applicant's services in connection with its mark will also be able to distinguish between Applicant's services and those offered in connection with the marks discussed herein.

The Examiner has attempted to counter the foregoing arguments with two baseless assertions. First, she states that the Applicant has not argued that the various services covered by these third-party marks are related to each other or the cited registrants' marks. It is self-evident from a cursory review of the various covered services that they are related for the very reasons that she argues that the Applicant's and the cited registrants' services are related, namely, that "It is common for organizations providing marketing services to also provide business consultation and management and advice to businesses." The same could be said about many of the services covered by the above-discussed third-party registrations.

Second, the Examiner argues that many of the third-party registrations are no longer alive. This ignores the fact specifically stated by the Applicant that these marks were "previously registered at the time the cited marks were registered." Since they were then alive, they are relevant to the analysis of what marks should co-exist with the cited marks.

Based on the foregoing, Applicant respectfully submits that its mark should likewise be allowed to co-exist with the cited marks, on the grounds that the above marks have co-existed with each other and with the cited marks; and that Applicant's mark conveys a unique connotation distinguishable from those of the cited marks, thus negating any potential likelihood of confusion.

IV. CONCLUSION

For the foregoing reasons, it is respectfully requested that the Examiner's refusal to register the Applicant's Mark should be reversed and that the Applicant's Mark should be allowed to proceed to registration.

Respectfully submitted,

ICON S.R.L.

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